

REMARKS

Entry of the present amendment and reconsideration of the claims is respectfully requested.

I. Status of the Claims

Claim 22 has been added and the addition does not add new matter.

Claims 1 and 17-21 have been amended and the amendments do not add new matter.

Claims 1-9 and 11-22 are pending in the application.

II. Telephone Interview

Applicants would like to thank Examiner Hewitt and Supervising Examiner Trammel for all of the courtesies extended in the telephone interviews held on March 9 and March 13, 2004. The terms “transparently transmitting” and “without notifying a user” were discussed. Supervising Examiner Trammel expressed the concern that “without notifying a user” is a negative limitation and renders the claims indefinite. The claims have been amended to recite the original terminology of “transparently transmitting”. Further, the claims and the art of record were discussed and no agreement was reached.

III. Rejections Under 35 U.S.C. § 112

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement for the term “renewing the parameters without notifying the user”. Claims 1-21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite regarding the term “renewing the parameters without notifying the user”. Applicants have amended claims 1 and 17-21 to recite “transparently transmitting” instead of “without notifying a user”.

Applicants did not amend the claims in response to the Examiner's § 112, first and second paragraph rejections above. Applicants amended the claims solely in response to Supervising Examiner Trammel's concern that "without notifying a user" is a negative limitation, and such amendment merely reintroduces the original language of the claims.

Applicants disagree with the Examiner's statement that the written description does not support this limitation. The terms "transparent" and "without notifying a user" are essentially synonymous to those of ordinary skill in the art of computer technology and a further discussion regarding the definitions of the terms is below. The Specification clearly states, in the Summary of the Invention, that the "present invention relates to a method and apparatus for dynamically and transparently renewing the licenses associated with downloaded content." Specification, page 4, lines 13-14. Additionally, as set forth in the Detailed Description, a user requests to download content and "License Files are then sent to the user's computer without notifying the user, and then the content is downloaded or streamed to the user." Specification, page 8, lines 7-8. Applicants submit that the Specification is not silent on the element of "renewing the parameters without notifying the user" and provides sufficient information to enable one of ordinary skill in the art to practice the invention.

Further, the Examiner contends that the Specification does not provide one of ordinary skill in the art the necessary data to implement the present invention. Applicants respectfully traverse the Examiner's contention. Applicants are not claiming a new and novel way to transparently transmit files to a user and submit that one of ordinary skill in the art possesses the knowledge to transparently transmit files. Part of the novelty in Applicants' claimed invention for a method and apparatus of protecting electronic files is the transmitting and renewing of licensing files without notifying a user (i.e. transparently). One of ordinary skill in the art possess the knowledge to

transparently transmit files to a user and the Specification and claims meet the disclosure requirements under 35 U.S.C. § 112, first and second paragraph.

IV. Rejections Under 35 U.S.C. § 103(a)

Claims 1-7 and 10-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,056,786 to Rivera et al. in view of U.S. Patent No. 6,009,401 to Horstmann. Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rivera in view of Horstmann and further in view of U.S. Patent No. 5,023,907 to Johnson et al.

The Examiner contends that Rivera discloses the entire invention except transmitting a license to a user; disseminating the content with the license; and creating a license for one or many pieces of content; that Horstmann discloses transmitting the license file to a user without notifying a user; and that Johnson discloses creating a license file for one or many pieces of content.

Regarding the terms “transparently” and “without notifying a user”, Applicants submit that the terms are essentially synonymous to those of ordinary skill in the art of computer technology. The Examiner previously contended that the term “transparent”, as used in claims 1-9 and 11-21, is defined in Webster’s Dictionary as “clear” and “easily detected” and that Horstmann transmits his files to the user “transparently” or “in the clear”. *See*, Office Action dated September 8, 2003, page 2 (paper no. 7). Applicants respectfully traverse the Examiner’s contention and the use of Webster’s Dictionary.

The courts, in reading a claim,

give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art. Accordingly, a technical term used in a patent is interpreted as having the meaning a person of ordinary skill in the field of the invention would understand it to mean. Dictionaries and technical treatises ... may sometimes be considered ... [but caution] against the use of non-scientific dictionaries.

Bell Atlantic Network Services v. Covad Communications, 262 F.3d 1258, 1267 (Fed. Cir. 2001) (internal citations omitted). Applicants respectfully request that the Examiner read the Specification and claims from the vantage point of one of ordinary skill in the art of computer technology. One of ordinary skill in the art knows that “transparent” is a term of art in the context of the Specification and transparent’s definition is known in the art as “not notifying a user” or “without any visible effect”. Applicants submit that the definition of “transparent” can be discerned from the Specification, *see*, the argument and citations above regarding the 35 U.S.C. § 112 rejections. Moreover, Webopedia.com (www.pcwebopaedia.com) describes itself as “The #1 online encyclopedia dedicated to computer technology”, and defines “transparent” as:

Invisible. In computer software, an action is transparent if it takes place without any visible effect. Transparency is usually considered to be a good characteristic of a system because it shields the user from the system's complexity.

Additionally, Applicants attach hereto, as Exhibit A, a copy of the definition of “transparency” and “transparent” from Newton’s Telecom Dictionary, 18th Edition, *CMP Books*, 2002, page 763. “Transparency” is defined there as the “transportation of information invisible to the user” and “transparent” as a “feature … the user … is totally unaware that it exists.” Applicants respectfully submit that the definition of the terms “transparent” and “without notifying a user” are defined in the Specification and are consistent with the meetings ascribed to them by those of ordinary skill in the art of computer technology.

Applicants therefore respectfully traverse the above rejections. Applicants have amended claims 1 and 19-21 to recite the elements that the license file is “transparently transmitted” to the user. Horstmann discloses transmitting a license file, but does not teach or suggest transmitting the license file “transparently,” i.e. without the user’s knowledge.

Horstmann specifically teaches transmitting license files with the user's knowledge. Horstmann's "license certificate is preferably backed up by the end user onto a floppy disk or other permanent storage medium ... [and] in an emergency, it may be retrieved from the clearinghouse or merchant." Horstmann, column 3, line 67 to column 4, line 6. Since a user must create the back up or initiate the request for the license certificate, the user must have knowledge of the license file and therefore the license certificate is never "transparently transmitted" to the user. Thus, Horstmann does not teach or disclose the transparent transmission of the license file as required by the present claims.

Additionally, neither Rivera nor Johnson teach or suggest the elements lacking from Horstmann and present in the claims.

Claims 2-9, and 11-18 depend from claims 1 and 21 respectively, and are patentable for at least the same reasons set forth above for the independent claims. Thus, Applicants respectfully request that the above rejections be withdrawn.

CONCLUSION

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved by either a Supplemental Response or a Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated: March 31, 2004

Respectfully submitted,

By


Louis J. DelJindice
Registration No.: 47,522
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 753-6237 (Fax)
Agent for Applicants